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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,495	03/17/2004	Mendez-Gallon Benjamin	VOI0247.CON	6751

7590

11/27/2006

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EXAMINER

LAMB, BRENDA A

ART UNIT

PAPER NUMBER

1734

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

8

Office Action Summary	Application No. 10/802,495	Applicant(s) BENJAMIN ET AL.	
	Examiner Brenda A. Lamb	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 8/18/2006 and 5/26/2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38 and 40-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38, 57-71 and 73 is/are allowed.
- 6) ☒ Claim(s) 41-56 and 72 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 42-56 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The originally filed specification fails to teach or suggest a floating potential electrode which receives an electrical field from the electrode arrangement, positioned between the suction box and trailing scraper, and imparts an electric field to the moving substrate.

If applicant disagrees then applicant needs to point out support in the specification and/or drawings for a floating potential electrode which receives an electrical field from the electrode arrangement, positioned between the suction box and trailing scraper, which imparts an electric field to the moving substrate.

The originally filed specification fails to teach or suggest a magnetic field device may work with electrode arrangement, floating potential and suction box with trailing blade to influence movement of the application medium jet as a means for imparting a magnetic field to the application medium jet as it travels toward the substrate.

If applicant disagrees then applicant needs to point out support in the specification and/or drawings for a magnetic field device may work with electrode arrangement, floating potential and suction box with trailing blade to influence movement of the application medium jet as a means for imparting a magnetic field to the application medium jet as it travels toward the substrate.

Claims 41-56 and 72 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The examiner maintains the rejection of claim 41 and 72 as set forth in the last office action.

Claim 41 is confusing since it unclear how the electrode arrangement arranged upstream of the applicator unit relates to the electrode arrangement set forth in claim 38. Claim 72 is confusing since it unclear how the electrode relates to the electrode arrangement in claim 66. Claim 42 is confusing due to a typographical error. At line 16 of claim 42 after "said electrode arrangement being" delete "positions" and insert -- positioned --.

The proposed drawing correction and/or the proposed substitute sheets of drawings filed on 12/12/2005 have been disapproved because they introduce new matter into the drawings. 37 CFR 1.121(a)(6) states that no amendment may introduce new matter into the disclosure of an application. The original disclosure does not support the showing of a magnetic field device which is arranged on the downstream side of the applicator unit and upstream of electrode arrangement 46.

Applicant's arguments filed 8/18/2006 and 5/26/2006 have been fully considered but they are not persuasive.

Applicant's argument that the originally filed specification starting at page 16 line 19 teaches an electrode arrangement 40 that has a floating potential that receives a charge and imparts a charge to the substrate is found to be non-persuasive since it is not commensurate in scope with claim limitations. First of all, the originally filed specification at page 16 line 19 to page 17 line 8 or paragraph 0045-0046 teaches that an electric field is imparted to the air boundary which occurs above the substrate by the floating potential electrode and is silent to floating potential electrode imparting an electric field directly to the substrate. Further, it is noted that the originally filed specification teaches at paragraph 0049 or page 18 lines 1-9 that the web or substrate is kept ground potential via web guide elements 48 (also see originally filed claim 53). Further, it is noted that applicant has claimed the device for applying the coating to at least one side of the substrate includes the following separately claimed elements - a floating potential electrode and an electrode arrangement between the suction box and the trailing scraper which produces an electric field which exerts a force on the application medium jet as it moves from the applicator to the substrate yet applicant has argued that the electrode arrangement between the suction box and the trailing scraper (element 40) and the floating potential electrode are one and the same which is supported by the originally filed specification at a paragraph 0026 and 0045.

Applicant's argument that the originally filed specification fails to teach information as to the positioning of the magnetic field device at any location and the

magnetic field device depicted in the amended drawing is consistent with the element contained in the claim is found to be non-persuasive. The examiner agrees with applicant in that the originally filed specification fails to teach information as to the positioning of the magnetic field device at any location and therefore the examiner maintains that the depiction of the magnetic field device upstream of the curtain flowing from the curtain applicator unit upstream of electrode arrangement 46 presents new matter.

Claims 38,57-71 and 73 are allowed.

Claims 41 and 72 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

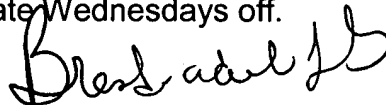
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

Art Unit: 1734

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to Brenda A. Lamb at telephone number (571) 272-1231. The examiner can normally be reached on Monday-Tuesday and Thursday-Friday with alternate Wednesdays off.

A handwritten signature in black ink, appearing to read "Brenda A. Lamb", with a stylized flourish at the end.

Brenda A Lamb
Examiner
Art Unit 1734